

REMARKS

Claims 1-25 are pending.

Claims 10-13 stand allowed.

Reply to Rejections

First Rejection

Claims 1, 4-7, 9 and 14-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,943,603 to Parulski, et al. (Parulski) of record. This rejection is traversed.

The Office Action does at least recognize that Parulski discloses a combined cellular telephone/digital camera and to establish obviousness the Office Action at the bottom of page 3 of the Office Action and following sets forth reasons why the Examiner considered the subject matter obvious. The reasons of the Examiner are set forth as follows: “that because of the teachings of Parulski in Fig. 1 it would have been obvious to separate the digital camera and the cellular device into two parts.” See also page 4 of the Office Action. But this is speculation.

The Examiner, in the second full paragraph on page 4 of the Office Action, stated other reasons why the combination was obvious. The Examiner cites MPEP 2142.V.C., the undersigned is not aware of this citation in the MPEP, it may be that the Examiner meant to cite MPEP 2141.02. Clarification is requested.

Initially, in Parulski, Fig. 7 and Fig. 1, there are two different embodiments. Actually, there is no motivation outside of the Applicants' own disclosure to modify the reference in the manner set forth. Certainly there is no suggestion in the reference to separate the digital camera and cellular device as claimed.

But more importantly what the Examiner has failed to consider is the unexpected results achieved by the combination. These results are set forth, for example, starting on page 2 of the specification. For example, the combination has cured the inconvenience previously present in the prior art. In arriving at the conclusion of obviousness, the Examiner must consider the results achieved. See *The Gillette Co. v. S. C. Johnson & Son, Inc.* 16 USPQ 2d. 1923 (Fed.Cir. 1990) wherein the Court stated as follows:

“An analysis of obviousness of a claim combination must include consideration of the results achieved by the combination. As we explained in *Interconnect Planning Corp. v. Feil*, 774 Fed. 2d 1132, 1143, 227 USPQ 543, 551 (Fed.Cir. 1985) [cited in the MPEP].”

It is quite clear that the Examiner has failed to give consideration to the unexpected result.

The comments set forth above also apply to independent claim 7.

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 U.S.C. § 103.

Second Rejection

Claims 3 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski as applied to claims 1 and 7 above. This rejection is traversed. The explanation regarding the rejection on Parulski with respect to claims 1 and 7 is incorporated herein by reference.

The Examiner takes “official notice” in the Office Action, first paragraph, page 7. But no evidence has been provided to support the Examiner’s position. Also, the undersigned challenges the Examiner’s assertion “of a digital camera that records a batch file where the file name or contents are written in advance, and where the file is read out and sent to a communication apparatus on the network, would have been well known in the art”. The Examiner is requested to supply evidence of this assertion. See *In re Ahlert*, 424 Fed. 2d 1088, 165 USPQ, 418 (CCDA 1970) cited in the MPEP, for example in Section 2144.03e.

With respect to the Examiner’s assertion that the official notice statement has been admitted, this is traversed. It is considered that the Applicants have seasonably challenged this statement of official notice and the admission is not viable. See, Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/89) where it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v.

Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor n Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

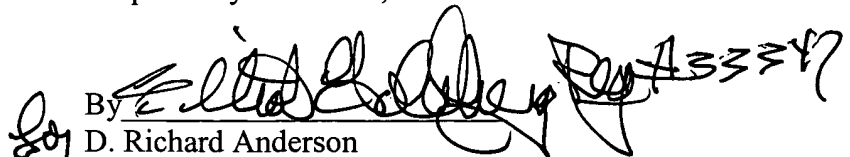
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Dated: September 16, 2005

Respectfully submitted,

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